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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/624,076	07/24/2000	Robert Scott Nieboer	2907-102P	5065

7590 05/19/2005

Anthony Laws Birch  
6915 Barrett Lane  
Bethesda, MD 20814

EXAMINER
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PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/624,076

Applicant(s)

NIEBOER ET AL.

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-24 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

RD

**DETAILED ACTION**

1. This communication is in response to amendment filed 1/31/2005.

***Response to Amendment/Remarks***

2. No claim has been amended.
3. Applicant's response concerning 112 (first) rejection for lacking sufficient written description is fully considered. However, the applicant's arguments and evidence is not sufficient to overcome the 112 (first) rejection as explained in the following paragraphs. Accordingly all claims stand rejected under 35 USC 112 (first) as lacking sufficient written description. Please refer to the following detailed explanation.
4. It is recognized that the present application is a CIP of the SN 09/359,686 (now Patent 6,418,419) which is titled "Automatic System and Conditional Order Transactions in Securities or Other Items in Commerce".
5. The claimed subject matter under scrutiny pertains to "establishment and maximization of the sales prices of a generic set of fungible items". In particular, the applicant claims that the process step of "completing sales in the primary auction based on sales results in the secondary auction thereby establishing and maximizing the sales price of said generic set of fungible items as an independent function of sales price of the second price of fungible items using a computer".

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6. A thorough review of the '419 patent does not recite the embodiment of trading process comprising primary auction and secondary auction which is the subject application. Therefore, '419 patent does not lend any support for the written description for the claimed invention in any detail.
7. The applicant argues that Declaration under 37 CFR 1.132 of Jeremy Sanders arguing that this declaration meets the standard for written description and that the contested new matter is within skill of one of ordinary skill in the art.
8. This argument is not persuasive because what may or not be obvious to one of ordinary skill in the art is not the test for a new matter *Lockwood vs. Anderson*, 41USPQ 2d @1966.
9. Applicant has the burden of showing that a person of skill in the art "would have understood, at the time of the patent application was filed, that the description requires the limitation." *Hyatt*, 47USPQ 2d @1131.
10. The applicant is required to show that the applicant had in his or her possession, as of the filing date of the application, the specific subject matter claimed by the applicant using such descriptive means as words, structures, figures, diagrams and formulas that set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 41 USPQ2d 1961 (Fed. Cir. 1997).

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11. It is noted that, present invention does not show any descriptive means that show that the applicant had in their possession, the claimed subject matter since there is no description of a computer being used for the recited "completing sales" step of claim 1. In contrast, the '419 patent clearly shows the claimed embodiments of the pertinent application using Figures 1-3 and detailed description of the figures throughout the specification. In conclusion, the specification is silent about any form of technological implement including a computer to carry out the claimed invention. In particular, the specification as originally filed fails to show any descriptive means such as those enumerated above in support of the claimed invention as being implemented on a computer and thus fails to meet the written description requirement under 35 U.S.C. 112, first paragraph and therefore claims<sup>1-24</sup> stand rejected as stated in the prior office action.

#### **Conclusion**

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS

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of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### **Conclusion**

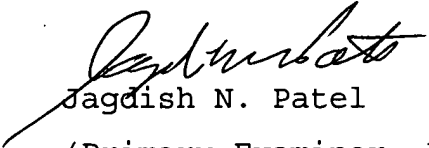
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571)272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

5/13/05